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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/866,570	05/25/2001	Rodney B. Croteau	4630-59094	4771

7590

09/23/2002

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EXAMINER

KERR, KATHLEEN M

ART UNIT

PAPER NUMBER

1652

DATE MAILED: 09/23/2002 11

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/866,570

Applicant(s)

CROTEAU ET AL.

Examiner

Kathleen M Kerr

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 May 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-6,8-11,14,16,18 and 23-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1,3-6,8-11,14,16,18 and 23-27 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Application Status

1. Claims 1, 3-6, 8-11, 14, 16, 18, and 23-27 are pending in the instant application by virtue of a preliminary amendment filed on May 25, 2002 (Paper No. 10).

Restriction

2. Restriction to one of the following inventions (Groups) is required under 35 U.S.C. § 121. The restriction below is structured with SuperGroups which are further divided into Groups for ease of explanation:

SuperGroup A. Claims 1, 9, 18, and 23, drawn to transacylases, classified in class 435, subclass 193.

SuperGroup B. Claims 3-6, 8, 10-11, 14, 16, and 24-27, drawn to nucleic acid molecules and host cells encoding transacylases, classified in class 435, subclass 252.3.

- | | |
|-------------|---|
| Group I. | Claims from SuperGroup A related to SEQ ID NOs:1/2. |
| Group II. | Claims from SuperGroup A related to SEQ ID NOs:3/4. |
| Group III. | Claims from SuperGroup A related to SEQ ID NOs:5/6. |
| Group IV. | Claims from SuperGroup A related to SEQ ID NOs:7/8. |
| Group V. | Claims from SuperGroup A related to SEQ ID NOs:9/10. |
| Group VI. | Claims from SuperGroup A related to SEQ ID NOs:11/12. |
| Group VII. | Claims from SuperGroup A related to SEQ ID NOs:13/14. |
| Group VIII. | Claims from SuperGroup A related to SEQ ID NOs:15/16. |
| Group IX. | Claims from SuperGroup A related to SEQ ID NOs:17/18. |
| Group X. | Claims from SuperGroup A related to SEQ ID NOs:19/20. |
| Group XI. | Claims from SuperGroup A related to SEQ ID NOs:21/22. |
| Group XII. | Claims from SuperGroup A related to SEQ ID NOs:23/24. |
| Group XIII. | Claims from SuperGroup A related to SEQ ID NOs:25/26. |
| Group XIV. | Claims from SuperGroup A related to SEQ ID NOs:27/28. |
| Group XV. | Claims from SuperGroup A related to SEQ ID NOs:44/45. |
| Group XVI. | Claims from SuperGroup A related to SEQ ID NOs:49/50. |
| Group XVII. | Claims from SuperGroup A related to SEQ ID NOs:51/52. |

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Group XVIII. Claims from SuperGroup A related to SEQ ID NOs:53/54.
Group XIX. Claims from SuperGroup A related to SEQ ID NOs:55/56.
Group XX. Claims from SuperGroup A related to SEQ ID NOs:57/58.
Group XXI. Claims from SuperGroup B related to SEQ ID NOs:1/2.
Group XXII. Claims from SuperGroup B related to SEQ ID NOs:3/4.
Group XXIII. Claims from SuperGroup B related to SEQ ID NOs:5/6.
Group XXIV. Claims from SuperGroup B related to SEQ ID NOs:7/8.
Group XXV. Claims from SuperGroup B related to SEQ ID NOs:9/10.
Group XXVI. Claims from SuperGroup B related to SEQ ID NOs:11/12.
Group XXVII. Claims from SuperGroup B related to SEQ ID NOs:13/14.
Group XXVIII. Claims from SuperGroup B related to SEQ ID NOs:15/16.
Group XXIX. Claims from SuperGroup B related to SEQ ID NOs:17/18.
Group XXX. Claims from SuperGroup B related to SEQ ID NOs:19/20.
Group XXXI. Claims from SuperGroup B related to SEQ ID NOs:21/22.
Group XXXII. Claims from SuperGroup B related to SEQ ID NOs:23/24.
Group XXXIII. Claims from SuperGroup B related to SEQ ID NOs:25/26.
Group XXXIV. Claims from SuperGroup B related to SEQ ID NOs:27/28.
Group XXXV. Claims from SuperGroup B related to SEQ ID NOs:44/45.
Group XXXVI. Claims from SuperGroup B related to SEQ ID NOs:49/50.
Group XXXVII. Claims from SuperGroup B related to SEQ ID NOs:51/52.
Group XXXVIII. Claims from SuperGroup B related to SEQ ID NOs:53/54.
Group XXXIX. Claims from SuperGroup B related to SEQ ID NOs:55/56.
Group XL. Claims from SuperGroup B related to SEQ ID NOs:57/58.

3. The inventions are distinct, each from the other because of the following reasons:

All the members of SuperGroup A are related as polypeptides; these are disclosed as having transacylase activity and all being from the same source, *Taxus caspidata*. However, the Groups within SuperGroup A are distinct, each from the other, by virtue of their distinct sequences (structures). Thus, each member of SuperGroup A is patentably distinct, each from the other. Moreover, each sequence recited in Claim 1 is wholly distinct from every other sequence and must be separately searched. Since these sequence searches neither overlap nor are co-extensive, grouping any two Groups of SuperGroup A to be searched together would present a search burden on the examiner.

All the members of SuperGroup B are related as nucleic acid sequences encoding polypeptides; these polypeptides are disclosed as having transacylase activity and all being from the same source, *Taxus caspidata*. However, the Groups within SuperGroup B are distinct, each from the other, by virtue of their distinct sequences (structures). Thus, each member of SuperGroup B is patentably distinct, each from the other. Moreover, each sequence recited in Claim 4 is wholly distinct from every other sequence and must be separately searched. Since these sequence searches neither overlap nor are co-extensive, grouping any two Groups of SuperGroup B to be searched together would present a search burden on the examiner.

The corresponding proteins of SuperGroup A and DNAs of SuperGroup B are related to each other by virtue of the fact that the DNA encodes the proteins. The DNA molecule has utility for the recombinant production of the proteins in a host cell. Although the DNA and the proteins are related, they are distinct inventions because the enzyme product can be made by other and materially distinct processes, such as purification from a natural source, *Taxus caspidata*. Furthermore, DNA can be used for processes other than the production of proteins, such as nucleic acid hybridization assays. Therefore, corresponding members of SuperGroups A and B are patentably distinct. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Election

4. A telephone call was made to Donald Stephens on September 20, 2002 to request an oral election to the above restriction requirement, but did not result in an election being made.

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Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 C.F.R. § 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(i).

Conclusion

5. A complete response to the instant Office action must include an election of invention (Group) to be examined. Election of a SuperGroup would be considered non-responsive.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kathleen M Kerr whose telephone number is (703) 305-1229. The examiner can normally be reached on Monday through Friday, from 8:30am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathupura Achutamurthy can be reached on (703) 308-3804. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-0294 for regular communications and (703) 305-3014 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

KMK

September 20, 2002

